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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,043	11/09/2001	Julian Mitchell	476-2062	5564

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EXAMINER

BENGZON, GREG C

ART UNIT PAPER NUMBER

2144

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,043

Applicant(s)

MITCHELL ET AL.

Examiner

Greg Bengzon

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This application has been examined. Claims 1- 28 are pending.

Priority

The effective date of the subject matter in the claims in this application is November 9, 2001.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on 11/09/2001, 10/01/2002, and 01/08/2004 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 14 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 14 cites a middlebox control node 'wherein said middlebox control node is distributed and comprises more than one node in the communications network'. The Examiner notes that the Applicant's specifications have not sufficiently disclosed said distributed control node comprising of more than one node.

Though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.

The Examiner notes that specification was not enabling with respect to the said claims at issue, noting further that there was no considerable direction and guidance in the specification; that there was no evidence presented by the Applicant of a high level of skill in the art at the time the application was filed; and also no evidence presented that all of the methods needed to practice the invention were well known.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 18, 24, 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "more directly connected" in claims 1, 18, 24 is a relative term which renders the claim indefinite. The term "more directly connected" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The term "to control said first middlebox" in claims 1, 18, 24, and 25 is a relative term which renders the claim indefinite. The term "to control said first middlebox" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 25, 26, 28 recite the limitation "computer program" in Claim 23 and 25. There is insufficient antecedent basis for this limitation in the claims.

Claims 27 recites the limitation "computer program" in Claim 24. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 21-22 describe 'signals', said signals do not belong to any classification of statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12, 14-16, 18-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuster et al. (US Patent 6822957) hereinafter referred to as

Schuster, in view of Huitema (IETF Working Document 'MIDCOM Scenarios'), further in view of Handley et al. (IETF Working Document RFC2327 'SDP:Session Description Protocol'), hereinafter referred to as Handley .

For the purpose of examination, due to the 35 U.S.C. 112, second paragraph deficiency previously cited, Claims 25-28 are interpreted to describe a 'middlebox control node' and 'middlebox-identity-providing node' instead of 'computer program' as currently submitted by the Applicant .

With respect to Claim 1, Schuster discloses a method of controlling one of a plurality of NAT devices in a communications network, each of the NAT devices being connected to a plurality of entities in an address realm of the communications network, (Figures 1-2, 9-10, 13-14) said method comprising the steps of: (i) receiving a control message at a NAT -identity-providing node in the communications network, said control message comprising information about one of the entities in the communications network; (Column 19 Lines 15-30) (ii) using the NAT identity providing node to determine the identity of a first NAT connected to said one entity; (Column 19 Lines 40-65) (iii) sending said identity to a NAT control node in the communications network in order to control said first NAT ; and wherein the NAT -identity-providing node (Items 26, 38, 40, 44) is separate from the NAT control node (Item 18) and is more directly connected to said one of the entities than the NAT control node. (Column 18 Lines 50-65, Column 23 Lines 10-50)

With respect to Claim 2, Schuster discloses a method as claimed in claim 1 wherein said step (iii) of sending said identity comprises adding said identity to a control message and sending said control message. (Figure 13-14, Column 23 Lines 20-25)

With respect to Claim 3, Schuster discloses a method as claimed in claim 2 wherein additional information is also added to the control message. (Figure 13-14, Column 23 Lines 20-25)

With respect to Claim 6, Schuster discloses a method as claimed in claim 1 wherein said control message is a call set-up message and said method is arranged to control said first NAT in order to set-up a call from said one entity to another entity connected to a second NAT in the communications network. (Column 19 Lines 15-30)

With respect to Claim 7, Schuster discloses a method as claimed in claim 6 wherein said second NAT is connected to a plurality of entities in a second address realm different from the first address realm of the entities connected to the first NAT . (Figure 1, Column 5 Lines 30-50)

With respect to Claim 8, Schuster discloses a method as claimed in claim 7 wherein the NAT control node is within a third address realm different from the first and second address realms. (Figure 1, Column 5 Lines 30-50)

With respect to Claim 9, Schuster discloses a method as claimed in claim 8 wherein the third address realm is public. (Figure 1, Column 5 Lines 30-50)

With respect to Claim 10, Schuster discloses a method as claimed in claim 9 wherein the first and second address realms are private. (Figure 1, Column 5 Lines 30-50)

With respect to Claim 11, Schuster discloses a method as claimed in claim 1 wherein the NAT -identity-providing node is selected from: one of the NATs; a gateway in the communications network; said one entity, being a user terminal in the communications network; a gateway comprising a business services channel manager (BSCM). (Column 19 Lines 45-55)

With respect to Claim 12, Schuster discloses a method as claimed in claim 6 wherein said call passes through two or more NAT s and wherein information about the identity of each such NAT is added to said control message. (Figure 7, Column 14 Lines 20-45, Column 22 Lines 60-65)

With respect to Claim 14, Schuster discloses a method as claimed in claim 1 wherein said NAT control node is distributed and comprises more than one node in the communications network. (Figure 7, Column 14 Lines 20-45, Column 22 Lines 60-65)

With respect to Claim 15, Schuster discloses a method as claimed in claim 1 wherein each of the NAT es is selected from, a firewall, a network address translator (NAT), and a quality of service device . (Column 6 Lines 25-30)

With respect to Claim 16, Schuster discloses a method as claimed in claim 1 wherein said NAT -identity-providing node is arranged to determine the identity of the first NAT by using pre-specified information. (Column 16 Lines 30-40)

With respect to Claims 18-19, the Applicant describes a communications network having the same limitations as described in Claims 1-12, 14-16. Claims 18-19 are rejected on the same basis as Claims 1-12, 14-16.

With respect to Claim 22, Schuster discloses a signal as claimed in claim 21 wherein said information about the identity of a middlebox is selected from, a fully-qualified domain name (FQDN) and an internet protocol address(Column 19 Lines 15-30)

With respect to Claims 23, 25, 26, and 28, the Applicant describes a control node with the same limitations as described in Claims 1-12, 14-16. Claims 23, 25, 26, and 28 are rejected on the same basis as Claims 1-12, 14-16.

With respect to Claims 24, 27 the Applicant describes a identity-providing node with the same limitations as described in Claims 1-12, 14-16. Claims 24,27 are rejected on the same basis as Claims 1-12, 14-16.

However Schuster does not disclose certain features of the invention, as follows:

With respect to Claims 1-12, 14-16, 18-27, Schuster does not disclose of a middlebox device in the network.

With respect to Claim 4, Schuster does not disclose a method as claimed in claim 2 wherein said control message is a session description protocol (SDP) message.

With respect to Claim 5, Schuster does not disclose a method as claimed in claim 4 wherein said identity is added to an SDP message using a pre-specified SDP attribute

With respect to Claim 20, Schuster does not disclose a communications network as claimed in claim 19 wherein said control message is a session description protocol message.

With respect to Claim 21, Schuster does not disclose a signal comprising a session description protocol message comprising an attribute containing information about the identity of a middlebox.

Huitema discloses of different scenarios for describing the MIDCOM protocol as used for devices in the network that provide transport policy enforcement. Huitema discloses that examples of said 'policy enforcement' devices include firewall and network address translators, such devices being a subset of what are otherwise referred to as 'middleboxes'. (Abstract) Huitema also discloses that session description protocol (SDP) messages may be used to initiate and facilitate the communication control process between the middleboxes and the other devices involved. The SDP messages may include identification information regarding the middlebox. (Section 2.3.6 Multiple Ports, Port Ranges)

Handley discloses of the Session Description Protocol including specifications for passing pre-defined attributes regarding the session and media involved in the session. The 'attribute' mechanism ("a=" described below) is the primary means for extending SDP and tailoring it to particular applications or media. Some attributes (the ones listed in this document) have a defined meaning but others may be added on an application-, media- or session-specific basis. (Section 6 – SDP Specification)

Schuster , Huitema and Handley are analogous art because they present concepts and practices regarding communication control for middlebox devices such as NATs and firewalls.

The Examiner respectfully suggests that at the time of the invention it would have been obvious to combine the teachings on middleboxes and SDP messages by Huitema into Schuster . The combination of Huitema into the network of Schuster would 1) enable the devices in the network to communicate and pass identification information using the SDP messages, and 2) enable the public and private networks (and their respective call control management systems) of Schuster to recognize and control the NAT as a 'middlebox'. The suggested motivation for doing so would be, as Huitema suggests, enable the network of Schuster to 1) allow for third parties to provide transport policy enforcement, and 2) overcome the traversal scenarios that Huitema describes. (Abstract, Introduction)

Furthermore, the Examiner respectfully suggests that at the time of the invention it would have been obvious to combine the teachings regarding pre-defined attributes mechanisms on SDP messages by Handley into the combined teachings of Huitema and Schuster . The said combination of Handley into the combined network of Huitema and Schuster would facilitate sending the identity information from the middlebox to the other devices in the network. The suggested motivation for combining would have been, as Handley suggests, in order to have a standard format for session initiation-related information, using text in the ISO 10646 character set in UTF-8 encoding for enhanced portability. The encoding was designed with strict order and

formatting rules so that most errors would result in malformed announcements which could be detected easily and discarded. This also allows rapid discarding of encrypted announcements for which a receiver does not have the correct key. (Section 6 – SDP Specification)

Therefore it would have been obvious to combine Huitema into Schuster, and further combine Handley into the combination of Huitema and Schuster, in order to arrive at the invention as described in Claims 1-12, 14-16, 18-27.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schuster et al. (US Patent 6822957) hereinafter referred to as Schuster, in view of Huitema (IETF Working Document 'MIDCOM Scenarios'), further in view of Handley et al. (IETF Working Document RFC2327 'SDP:Session Description Protocol'), hereinafter referred to as Handley, further in view of Srisuresh et al. (IETF Working Document 'Middlebox Communication Architecture and Framework'), hereinafter referred to as Srisuresh.

With respect to Claim 13, the combination of Schuster, Huitema and Handley do not disclose a method as claimed in claim 1 wherein said NAT control node is a MIDCOM agent.

Srisuresh discloses the MIDCOM Architecture and Framework wherein the middlebox controlling node is called a MIDCOM agent. Srisuresh discloses said

MIDCOM agents to be nodes external to a middlebox, possessing a combination of application specific intelligence and knowledge of middlebox function so as to assist the middleboxes to perform their functions. (Section 4.0 MIDCOM Agents)

Schuster , Huitema, Handley and Srisuresh are analogous art because they present concepts and practices regarding communication control for middlebox devices such as NATs and firewalls. The Examiner respectfully suggests that at the time of the invention it would have been obvious to combine the teachings on MIDCOM agents by Srisuresh into the combination of Schuster , Huitema, and Handley . The combination of Srisuresh into the network of Schuster, Huitema, and Handley would 1) allow the registration servers, proxy servers, and other network devices configured for distributed network address translation to be enabled as a MIDCOM agents. The suggested motivation for doing so would have been, as Srisuresh suggests, to take advantage of existing in-path and out-of-path devices that already possess the application intelligence. (Section 4.1.1 In-Path MIDCOM Agent Illustration)

Therefore it would have been obvious to combine Srisuresh into the combination of Huitema, Schuster, and Handley in order to arrive at the invention as described in Claim 13.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schuster et al. (US Patent 6822957) hereinafter referred to as Schuster, in view of Huitema (IETF Working Document 'MIDCOM Scenarios'), further in view of Handley et al. (IETF Working Document RFC2327 'SDP:Session Description Protocol'), hereinafter referred to as Handley, further in view of Mahler et al. (US Patent 6381638), hereinafter referred to as Mahler .

With respect to Claim 17, the combination of Schuster, Huitema, and Handley do not disclose a method as claimed in claim 1 wherein said middlebox-identity-providing node is arranged to determine the identity of the first middlebox by automatically analysing the communications network.

Mahler discloses of communication protocol for NAT type devices, wherein the NAT router intercepts an outgoing packet and changes the source IP address of the packet equal to the IP address of the router itself. The modified packet is forwarded to the destination server. The socket created by the server reflects that the connection is between itself and the router, even though the actual connection is between itself and the originating host. (Column 4 Lines 10-50) Mahler also describes 1) sending router identifier information to the servers and 2) using address and port mapping tables in order to maintain recognition of the NAT router and reduce address translation during the actual session. (Figure 9, Column 11 Lines 55-65, Column 12 Lines 1-25) Using said protocol and method the server and other devices in the network are made aware of the NAT router.

Schuster, Huitema, Handley, and Mahler are analogous art because they present concepts and practices regarding communication control for middlebox devices such as NAT routers.

The Examiner respectfully suggests that at the time of the invention it would have been obvious to combine the teachings on detecting NAT devices by Mahler into the combination of Schuster, Huitema, and Handley. The combination of Mahler into the combination of Schuster, Huitema, and Handley would 1) other device in the network to detect the NAT device and determine the NAT device identification information. The suggested motivation for doing so would have been, as Mahler suggests, in order to overcome shortcomings for certain protocols when used in conjunction with NAT devices. (Column 3 Lines 1-10)

Therefore it would have been obvious to combine Mahler into the combination of Schuster, Huitema, and Handley, in order to arrive at the invention as described in Claim 17.

Conclusion

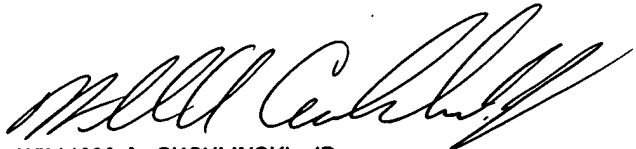
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to enclosed PTO-892 form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Bengzon whose telephone number is (571) 272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on (571)272-3925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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